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09/878,050	06/08/2001	Peter C. Boylan III	UV-197	1639

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EXAMINER

PAIK, STEVE S

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/878,050

Applicant(s)

BOYLAN ET AL.

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 117-119, 123-153, 270-272 and 276-336 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 117-119, 123-153, 270-272 and 276-336 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt is acknowledged of the Amendment filed April 28, 2003. The Amendment cancels claims 1-116, 120-122, 154-269, and 273-275 without prejudice. Furthermore, the amendment contains newly added claims 307-336.

### ***Information Disclosure Statement***

~~2. The information disclosure statement filed September 24, 2001 fails to comply with 37~~  
CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. The applicant requests the examiner to write and initial "All references have been considered" on the bottom of the Form PTO-1449. The examiner respectfully requests the applicant's attention to the copy of signed PTO-1449 for the IDS filed on September 24, 2001. All of the references listed on the Form PTO-1449 have been considered and initialed. The copy of the signed Form has been mailed to the applicant as an attachment to a Non-final Rejection (paper No. 7). Furthermore, the Print/Publication group prints all the references listed on the Form PTO-1449 which are reviewed and initialed by the Examiner. Therefore, if the applicant does not want a particular reference to be printed on a patent, the examiner may not write his or her initial. Although, the application (US Patent Application No. 09/330,792) is not listed on the Form PTO-1449, the examiner intends to review it as soon as it is available. Currently, the application is not available to the Examiner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 117-119, 123, 270-272, and 276 are rejected under 35 U.S.C. 102(e) as being anticipated by Cameron et al. (US 6,202,062).

Regarding claims 117-119 and 270-272, Cameron et al. discloses a method for using a portable scanning device for acquiring information associated with codes comprising:

scanning a code (2810) using a portable device (2800 in Fig. 28) wherein the portable device comprises code scanning equipment (col. 57, lines 35-36);

acquiring enhanced information associated with the scanned code (col. 57, line 37); and

providing the enhanced information associated with the code wherein the code is associated with an advertisement (magazine advertisement 2710; col. 55 lines 53-55), a promotion (such as 10% rebate and free delivery), or an article in a printed publication (col. 57, ll. 56-67).

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Regarding claims 123 and 276, Cameron et al. discloses a method for using a portable scanning device for acquiring information associated with codes comprising:

scanning a code (2810) using a portable device (2800 in Fig. 28) wherein the portable device comprises code scanning equipment (col. 57, lines 35-36);

acquiring enhanced information associated with the scanned code (col. 57, line 37); and

providing the enhanced information associated with the code wherein the code is scanned from another portable scanning device (Figs 29-31 show a PDA with a barcode. Cameron et al. teach that each PDA is equipped with scanning function that each PDA is capable of scanning a barcode from a paper publication, a product, etc. The PDAs in the market have been capable of communicating with other handheld devices via suitable wireless interfaces. Therefore, it is inherent that the enhanced information can be provided from a barcode scanned by another portable scanning device.).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 124-127, 129, 132, 133, 135-142, 144, 147, 148, 150-153, 277-280, 282, 285, 286, 288-295, 297, 300, 301, 303-310, 312, 315, 316, 318-325, 327, 330, 331, and 333-336 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (USP 5,939,695) in view of Ueda et al. (USP 4,866,258).

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Re claims 124, 136, 137, 139, 150-152, 277, 289, 290, 292, 303-305, 307, 319, 320, 322, 334, and 335, Nelson discloses a system (Fig. 4) and method for using a portable scanning device (Personal Communication System PCS 3 is equipped with a controller that based on the so-called "personal computer" architecture (col. 1, lines 66-67). This type of a controller inherently comprises a time keeping function which also has an alarm clock function to remind an appointment or to-do list and a function of transmitting and receiving an electronic mail message and/or an instant message) for acquiring information associated with codes (col. 2, lines 33-35). The PCS 3 includes functions of scanning a code (UPC, Universal Product Code) using a portable device (any one of 3 shown in Fig. 1A) wherein the portable device comprises code scanning equipment (a bar-code reader 12) and an output device (display 6), acquiring information associated with the scanned code (col. 2, lines 33-35), displaying (col. 2, lines 35-45) the acquired information (the acquired information may be associated with sales event of a product, good or service) on the output device (6), and performing an action related to a product, good, or service (the action initiated by a user may be ordering a particular product or saving information associated with the code, col. 6, lines 25-27) associated with the scanned barcode. However, he does not specifically disclose an action comprising scheduling the recording of televised programs.

Ueda discloses a barcode system for recognizing the data for reservation of a TV program in the video tape recording program system (equipment) and various other patterns (col. 1, lines 15-27). Almost all of the video tape recording system is equipped with a clock and timer which can remind the time and day of the week. The video tape recording system is also further equipped to provide (after scanning a barcode mark 7) audio and visual information (contained

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in a bar-coded list of TV program) in a plurality of different languages such as English, Spanish and French. This function of recognizing the data for reservation of a TV program is one of a few disclosed examples of a barcode system that allows a user to be able to record a desired TV program with minimum chance of recording other TV programs different from the desired one.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated the barcode reading system for recognizing the data for reservation of a TV program in the video tape recording program as taught by Ueda for the purpose of simplifying a tedious and time consuming selection and recording of a TV program or series.

Regarding claims 125, 140, 278, 293, 308, and 323, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, further comprising presenting the acquiring information to a user at the docking station (75 and col. 3, lines 28-37 which allows a different PCS to communicate with the base system see Fig. 4) via an output device at the docking station (col. 3, ll. 33-37 of Nelson).

Regarding claims 126, 141, 279, 294, 309, and 324, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, comprising presenting the acquired information to a user at the portable device (3) via an output device (6) at the portable device.

Regarding claims 127, 142, 280, 295, 310, and 325, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, wherein the information is acquired via a wireless path (col. 3, lines 6-27).

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Regarding claims 129, 144, 282, 297, 312, and 327, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, wherein the wireless path is a radio frequency path (rf network col. 3, line 15 and col. 3, lines 14-19 discloses that another type of wireless communication link may be equipped with the system. Another type of wireless communication link includes all of the recited types of wireless communication protocols).

Regarding claims 132, 133, 147, 148, 285, 286, 300, 301, 315, 316, 330, and 331, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, wherein the information is acquired via wired means (Fig. 4 and col. 3, line 18).

Regarding claims 135, 138, 153, 288, 291, 306, 318, 321, 333, and 336, Nelson in view of Ueda discloses the system (Fig. 4) and method as recited in rejected claims stated above, further comprising a specific user of the equipment based on which portable device was used to scan the code (Fig. 1A discloses a plurality of PCS' and the transactions or scanned results can be identified separately. Furthermore, the barcode information scanned from a barcode by a barcode scanner of Nelson can be transmitted to another portable barcode scanning device via the docking station using a wired or a wireless communication protocol.).

7. Claims 128, 130, 131, 143, 145, 146, 281, 283, 284, 296, 298, 299, 311, 313, 314, 326, 328, and 329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (USP 5,939,695) as modified by Ueda et al. (USP 4,866,258) as applied to claims stated above, and further in view of Ruppert et al. (USP 5,640,02).

The teachings of Nelson in view of Ueda have been discussed above. Nelson in view of Ueda discloses all of the features of the claimed invention with the exception of specifically

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disclosing a particular type of a wireless path and practical application of a portable personal scanner (Fig. 1).

Ruppert et al. disclose another type of wireless communication links used in data communication. Some information on infrared and radio wireless data transmission is publicly available through the IEEE 802.11 Wireless Networking Work Group. Furthermore, he teaches that the particular data communication interface and port are not critical to the invention, and selection of what type port to use depends upon the desired mode of operation for the device (col. 9, lines 50-55). He further discloses steps of building and modifying a shopping list using a scanner reading coded information on a product or good with the capability of alerting a price of a product (col. 7, lines 41-50).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated any one of available data communication protocols and a personal scanner using the protocols to generate and modify a list as taught by Ruppert et al. into the teachings of Nelson for the purpose of allowing design flexibility and maximizing the efficiency of acquiring information process since it is an obvious matter of design choice well within the art and providing more options and assistance to the user when shopping.

8. Claims 134, 149, 287, 302, 317, and 332 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (USP 5,939,695) as modified by Ueda et al. (USP 4,866,258) as applied to rejected claims stated above, and further in view of Allport. (USP 6,097,441).

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The teachings of Nelson in view of Ueda have been discussed above. Nelson in view of Ueda discloses all of the features of the claimed invention with the exception of specifically disclosing a particular type of a wired path.

Allport discloses a wired communication link using Firewire 1394 protocol wired communication between a hand-held remote control and a base station (col. 19, lines 12-15, claim 35). ~~A Firewire is one of many available wired data communication protocol which may be selected by network designer in accordance with specifications and cost of building a~~ network.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated any one of available wired data communication protocols as taught by Allport into the teachings of Nelson for the purpose of allowing design flexibility and maximizing the efficiency of acquiring information process since it is an obvious matter of design choice well within the art.

### ***Response to Arguments***

9. Applicant's arguments filed April 28, 2003 have been fully considered but they are not persuasive.

The applicant argues that the scanned item in the cited reference is a tangible product which is different from the applicant's invention (pages 15-16). The examiner respectfully intends to point out that the claims do not specifically recite the difference between steps of scanning a non-tangible item and a tangible item. However, the examiner has included another prior art of record to clearly point out that the scanned items in the reference are non-tangible items (see reference mentioned above). Therefore, the argument is not persuasive and moot. On

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page 17, the applicant argues that there is not showing or suggesting in Ueda to “acquire information associated with a scanned code....”. As this Office Action discusses, Nelson discloses reading/scanning a code to acquire information associated with codes (col. 2, ll. 33-35) and Ueda teaches making reservation processing by optically reading the barcode of a program from a bar-coded table of stations or channels, the date and the like to reserve in advance the program desired to be recoded (col. 1, ll. 20-27). Therefore, the examiner respectfully disagrees with the argument.

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In response to the applicant’s argument about the wherein clause, “wherein the language is determined by the user after the code is scanned.”, the examiner believes that the information is presented in a language determined by a user. The applicant explains that the language used to provide information based on scanning a code is a pre-programmed language (see page 18). While that statement is true, the information is never provided to the user until after the user scans the code. By making a decision to scan a barcode advertisement from a magazine written in a particular language yields a reasonable belief to the user that after scanning the barcode, user would see the encoded information in a language of the user’s preference. So the language selection process is automatically performed. Furthermore, nowadays, many of the websites, have a function to present a particular contents in many different languages.

In accordance with above art rejections and the response to the applicant’s arguments, the pending claims of 117-119, 123-153, 270-272, and 276-336 are rejected under 35 U.S.C. § 102 (e) or 103 (a).

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***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

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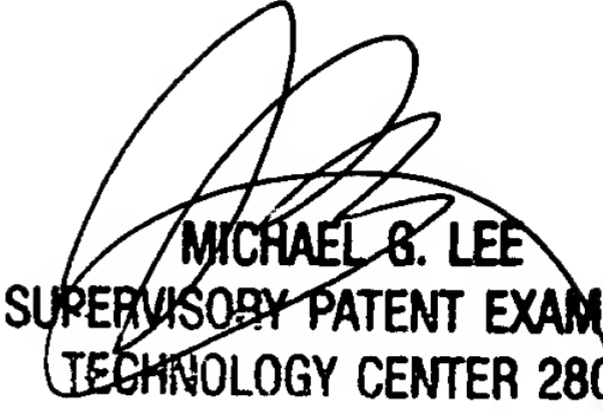
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*Steven Paik*

Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
August 4, 2003



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